

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT I. RUDKO

Appeal No. 95-4246
Application 08/201,052¹

HEARD: SEPTEMBER 17, 1997

Before McCANDLISH, *Senior Administrative Patent Judge*, STAAB
and McQUADE, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed February 24, 1994. According to appellant, the application is a continuation of Application 08/014,363, filed February 5, 1993, now abandoned, which is a continuation of Application 07/928,531, filed August 13, 1992, now abandoned, which is a continuation of Application 07/586,891, filed September 24, 1990, now abandoned.

Appeal No. 95-4246
Application 08/201,052

This is a decision on an appeal from the final rejection of claims 18-35, all the claims currently pending in the application. An amendment filed subsequent to the final rejection on August 28, 1995 (Paper No. 32) has not been entered. See the advisory letter mailed November 3, 1995 (Paper No. 33).

Appellant's invention pertains to a handpiece for use in a medical laser system. A basic understanding of the invention can be derived from a reading of exemplary claim 18, which reads as follows:

18. A handpiece for use in a transmyocardial revascularization heart synchronized pulsed laser system comprising:

a barrel having a passage for transmitting a laser beam; and

a contacting wall at one end of said barrel including an aperture in communication with said passage and a face extending continuously radially outward from said aperture to the periphery of said contacting wall.

The references of record relied upon by the examiner in support of the rejections are:

McFee 1925	1,562,460	Nov. 24,
Sharon et al. (Sharon) 1975	3,865,113	Feb. 11,
Hughes	4,757,515	Jul. 12,

Appeal No. 95-4246
Application 08/201,052

1988		
Johnson	4,850,352	Jul. 25,
1989		
Vassiliadis et al. (Vassiliadis)	4,940,411	Jul. 10,
1990		

The following rejections under 35 U.S.C. § 103 are before us for review:

(a) claims 18-23 and 31-35, rejected as being unpatentable over Sharon in view of McFee²;

(b) claims 24-27, rejected as being unpatentable over Sharon in view of McFee, and further in view of Johnson;

(c) claim 28, rejected as being unpatentable over Sharon in view of McFee, and further in view of Hughes; and

(d) claims 29 and 30³, rejected as being unpatentable over Sharon in view of McFee, and further in view of Vassiliadis.

The rejections are explained in the examiner's answer (Paper No. 29).

The opposing viewpoints of appellant are set forth in the

² Both the examiner and appellants have incorrectly denominated U. S. Patent No. 1,562,460 to McFee as "Fee".

³ Claim 30 is obviously incorrect in that it depends from itself. For purposes of this appeal, we will consider claim 30 as depending from claim 29. This error is deserving of correction in the event of further prosecution.

Appeal No. 95-4246
Application 08/201,052

brief (Paper No. 28) and the reply brief (Paper No. 30).

Considering first the examiner's rejection of independent claims 18, 31, 34 and 35 as being unpatentable over Sharon in view of McFee, the examiner has taken the following position:

These claims are met by Sharon '113 with the exception of providing the barrel with an enlarged contact surface including a solid face extending continuously radially outward from the aperture of the barrel; however, as Fee [sic, McFee] teaches using an enlarged contact surface in the form of a flange for contacting the surface of an area to be treated to stabilize and assist in orienting a surgical instrument[,] . . . providing Sharon '113, particularly the embodiment of Fig. 11[,] with the same in this manner for the benefits derived therefrom would have been considered as obvious modification. [final rejection, page 2]

Implicit in the above is the examiner's position that the modified Sharon device would correspond to the claimed handpiece in all respects.

While we are not in complete agreement with the examiner's position as stated above,⁴ the rejection is sustainable. Our reasons follow.

Each of the independent claims 18, 31 and 35 requires a

⁴ We do not agree with the examiner's implicit findings to the extent they suggest that the independent claims on appeal require the barrel to have an "enlarged" contact surface which includes a "solid" face, and that Sharon lacks such features.

contacting wall "at one end of said barrel." Similarly, independent claim 34 requires a contacting wall extending transversely "from one end of said barrel." In addition, each of the independent claims requires a face "extending continuously radially outward" from the aperture of the barrel to the periphery of the contacting wall.

Turning to Sharon, this references discloses a laser scalpel comprising a barrel 4, 6, 7 having a lens 8 for focusing a laser beam at the point 11, and a tip member for targeting the laser beam on a working spot or working line of cut. The tip member may take various forms, as illustrated in Figures 2-11. None of the embodiments disclosed by Sharon satisfies all of the claim requirements set forth in the previous paragraph. The Figure 5 embodiment and the Figure 11 embodiment of Sharon are most pertinent to the claimed invention. The Figure 5 embodiment, however, lacks a contacting wall "at one end of said barrel" (as required by claims 18, 31 and 35), and a contacting wall extending transversely "from one end of said barrel" (as required by claim 34). This is so because the leg 42 to which the tab 44 is secured is not itself a barrel, and cannot be fairly

considered to be a part of the barrel 4, 6, 7. As for the Figure 11 embodiment, Sharon explains at column 5, lines 28-37, that the tip member 100 may be made from a test tube or a centrifuge tube, with the laser beam being utilized to melt the bottom of the tube to form the opening 104. While the area of the tube immediately adjacent the aperture 104 may be broadly considered a "contacting wall" having a "face," it not clear that this face "extend[s] . . . radially outward" from the aperture 104, as required by each of the independent claims.

McFee pertains to a therapeutical device for producing a high frequency electrical discharge for treating tonsils or other parts to which access is more or less difficult (page 1, lines 9-14). The device includes an electrode 15 and a tubular protector 17, preferably made of glass (page 2, line 35). The protector serves to make it easier for the operator to hold the device at a proper distance from the part to be treated (page 1, lines 36-43). In one embodiment, illustrated in Figure 2, the protector is provided with an enlarged end in the shape of a substantially radially extending flange (page 1, line 100; page 2, line 78). The purposes of the enlarged

end include "[holding] the parts adjacent the part to be treated . . . away from the discharge by the protector" when the body part to be treated is located in a relatively confined space, "bear[ing] on the part to be treated," and "facilitat[ing] the holding of the electrode approximately perpendicular to the part to be treated" (page 1, lines 89-104).

From our perspective, it would have been obvious to one of ordinary skill in the art to provide the Figure 11 tip member of Sharon's laser scalpel with a radially extending flange in light of the combined teachings of the applied references. Suggestion for this modification is found in McFee's express teaching that this type of construction facilitates proper positioning of an energy beam relative to the body part to be treated when the instrument bears on the body part, and holds body parts adjacent the part to be treated away from the energy discharge when the body part to be treated is located in a relatively confined space, which teachings one of ordinary skill in the art would recognize as being applicable to Sharon's laser scalpel to bring about these same benefits. Independent claims 18, 31, 34 and 35

would not patentably distinguish over the Figure 1 handpiece of Sharon fitted with such a modified Figure 11 tip member.⁵

Appellant's arguments have been considered but are not persuasive that the examiner erred in rejecting claims 18, 31, 34 and 35. For the reasons noted above, we simply disagree with appellant that there is no suggestion to combine the references in the manner proposed. We also disagree with appellant that Sharon teaches away from providing a flange on tip member, or that providing Sharon's tip member with a flange would defeat Sharon's purpose because Sharon desires movement of a narrow tipped scalpel-type instrument. First of all, Sharon discloses a number of tip member configurations, at least some of which (e.g., the Figures 5, 6 and 7 embodiments) include a relatively broad end portion. In addition, as is made clear by Sharon at several places in the specification (e.g., column 3, lines 30), the laser beam may

⁵Furthermore, at least the independent claims on appeal would also not appear to distinguish over the protector 37 of McFee's Figure 2 embodiment taken by itself. In this regard, the protector 37 has a uniform diameter tubular body that comprises a barrel having an aperture capable of transmitting a laser beam and the radial flange 38 having at least an outer portion that comprises a contacting wall having a face extending continuously radially outwardly to the periphery.

Appeal No. 95-4246
Application 08/201,052

be used for cutting along a line *or for spot work*.

Appellant's argument that the combination of Sharon and McFee is the result of impermissible hindsight also is not well taken. From our standpoint, no impermissible hindsight reasoning has been relied upon by the examiner, since the rejection takes into account only knowledge which was within the level of ordinary skill at the time the presently claimed invention was made, i.e., the teachings of Sharon and McFee viewed as a whole, and does not include knowledge gleaned only from appellants' disclosure. See *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

We also do not agree with appellant's argument on pages 10-14 of the brief that the proposed combination would not result in the claimed subject matter. The preamble recitation of claim 18, for example, that the handpiece is "for use" in a heart synchronized pulsed laser system, and the recitation in the body of claim 35, for example, that the claimed structure "acts as a handpiece for contacting a beating heart during use," are statements of intended use or purpose that cannot be relied upon to distinguish the claimed handpiece over the

Appeal No. 95-4246
Application 08/201,052

applied prior art. See *LaBounty Manufacturing v. International Trade Commission*, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992); *In re Yanush*, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973); *In re Casey*, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); *Ex parte Cordova*, 10 USPQ2d 1949, 1950-51 (Bd. Pat. App. & Int. 1987). In any event, the modified Sharon handpiece reasonably appears to be fully capable of functioning in the manner called for in the claims.

As to the claim requirement that the face of the contacting wall "extend[s] continuously radially outward" from the aperture to the periphery, McFee describes the flange of protector 37 as being a "substantially radial" flange (page 1, line 100), or a "radial" flange (page 2, line 78). Hence, the tip member of Sharon's Figure 11 embodiment modified in accordance with McFee's teachings likewise would extend radially, at least for the portion thereof adjacent the periphery, which is sufficient to satisfy the broadly worded requirement of the independent claims in this regard. The modified tip member of Sharon would also satisfy the requirement of independent claim 34 calling for a contacting

wall "extending transversely from the end of the barrel" in that the radially extending flange of the modified tip member clearly would include at least a portion adjacent the periphery of the flange that "extend[s] transversely" from the end of the barrel.

On page 14 of the brief, appellant argues that "[w]hen a combination is properly made under Section 103, the disclosures being combined must specifically teach a structure which solves the same problem encountered by the appellant," and cite *In re Wright*, 848 F.2d 1216, 6 USPQ2d 1959 (Fed. Cir. 1988) in support of this position. We note, however, that the court in *In re Dillon*, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (*en banc*), *cert. denied*, 500 U.S. 904 (1991) overruled *Wright* on this point. The court also made it clear in *Dillon* at 919 F.2d 693, 16 USPQ2d 1901, that while all evidence of the properties of the claimed subject matter and the prior art must be considered in determining the ultimate question of patentability, the discovery that a claimed invention possesses a property not disclosed for the prior art subject matter does not by itself defeat a *prima facie* case of

obviousness.

On pages 16-25 of the brief, appellant makes reference to each of the appealed claims individually. Appellant presumably considers this to be a separate argument for each of the claims in favor of patentability. We note, however, that these "arguments" are ambiguous in that they merely restate the claim without specifying any *particular* feature thereof that is not suggested by the applied prior art. For example, on pages 19-20 appellants state:

Claim 19 is separately patentable because it recites that the handpiece further includes means for focusing a laser beam transmitted through the passage to focus the laser beam proximate the aperture to vaporize the tissue of the heart wall and create a hole therein. Neither Sharon nor Fee [sic, McFee] teach a handpiece for a transmyocardial revascularization heart synchronized pulsed laser system which includes means for focusing a laser beam transmitted through the passage to focus the laser beam proximate the aperture to vaporize the tissue of a heart wall and create a hole therein.

In that Sharon clearly discloses a lens 8 for focusing the laser beam at a point 11 at the end of the tip member, this "argument" is not well taken. Similarly, appellant's separate reference to each of the dependent claims 19-22, 32 and 33 does not convince us that the examiner erred in rejecting

Appeal No. 95-4246
Application 08/201,052

these claims as being unpatentable over Sharon in view of McFee.

As to claim 23, the meaning of the language "said contacting wall is broader in cross-sectional area than said barrel" is somewhat unclear in that it compares an area (the cross-sectional area of the contacting wall) to an element *per se* (the barrel). Giving this language its broadest reasonable interpretation, we interpret the above quoted language of claim 23 to mean that the diameter of the contacting wall is greater than the diameter of the barrel. As interpreted, claim 23 also does not patentably distinguish over the modified Sharon tip member.

In light of the foregoing, we will sustain the § 103 rejection of claims 18-23 and 31-35 as being unpatentable over Sharon in view of McFee.

Claims 24-26 depend from claim 18 and add that the barrel includes means for introducing a purging gas into the barrel (claim 24), means for venting debris purged by the gas from the barrel (claim 25), and the location of the exhaust means being proximate the aperture of the barrel (claim 26). We

consider the means for introducing a purging gas of claim 24 to be readable on the bore 46 in appellant's handpiece, and the means for venting of claim 25 to be readable on the holes 70, 72 of appellant's handpiece. The examiner's position that it would have been obvious to provide Sharon's tip member with a port for introducing a purging gas therein and a port for venting debris and purging gas therefrom in view of the teachings of Johnson at gas inlet port 18 and gas outlet port 20 is reasonable and has not been specifically disputed by appellants. Accordingly, we will sustain the standing rejection of claims 24-27 as being unpatentable over Sharon in view of McFee and Johnson.⁶

Claim 28 depends from claim 18 and further requires that the contacting wall is thermally insulating. In that the tip member 100 of Sharon's Figure 11 embodiment and the protector of McFee may be made of glass (Sharon, column 5, lines 28-30; McFee, page 2, line 35), which is a thermally insulating material at least to some degree, the subject matter of this

⁶ In that claim 27 depends directly from claim 18 and does not add anything to claim 18 above and beyond that disclosed by Sharon, it is not clear why this claim is grouped with claims 24-26.

Appeal No. 95-4246
Application 08/201,052

claim would have been obvious to the ordinarily skilled artisan in view of the combined teachings of the applied references.

Claim 29 depends from claim 18 and further requires that the barrel is angled and has a deflector means for directing the laser beam along the angled barrel. Claim 30 adds that the deflecting means is a mirror. It is the examiner's position that it would have been further obvious to provide Sharon with such features in view of the teachings of Vassiliadis in Figure 4 of a handpiece having an angled end portion and a mirror 80 for deflecting a laser beam therealong. In that the examiner's position is reasonable and has not been specifically disputed by appellants, we will also sustain this rejection.

Each of the examiner's rejections are sustained.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Appeal No. 95-4246
Application 08/201,052

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Appeal No. 95-4246
Application 08/201,052

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